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#8
C. Jones
1/23/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Akira Ishikawa, et al. ✓
Serial No. : 09/975,343 ✓
Filed : October 11, 2001 ✓
Title : MAGNETIC TAPE ✓

Art Unit : 1773 ✓
Examiner : Stevan A. Resan
Confirmation No.: 1181

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Commissioner for Patents
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RESPONSE

In an office communication dated December 10, 2002, the Examiner indicated that the Information Disclosure Statement filed on September 3, 2002 ("the IDS") was considered part of Applicants' response to the May 22, 2002 Office Action, and further that the IDS was "not fully responsive" because the most significant art was not highlighted. Although not explicitly stated in the communication, it appears that the Examiner is requiring Applicants to identify references in the IDS that are most relevant. Applicants respectfully traverse this requirement.

The office communication cites MPEP §2004, ¶13 for the proposition that Applicants are required to highlight art from the IDS that they consider to be most relevant. The opening paragraph of MPEP §2004 reads as follows:

While it is not appropriate to attempt to set forth procedures by which attorneys, agents, and other individuals may ensure compliance with the duty of disclosure, the items listed below are offered as examples of possible procedures which could help avoid problems with the duty of disclosure. *Though compliance with these procedures may not be required, they are*

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presented as helpful suggestions for avoiding duty of disclosure problems.
(emphasis added)

As stated above, MPEP §2004 merely sets forth possible procedures for complying with the duty of disclosure. Compliance with the procedures of MPEP §2004 is not required.

Paragraph 13 of MPEP §2004 cites Penn Yan Boats, Inc. v. Sea Lark Boats, Inc. 359 F.Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), aff'd, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), cert. denied 414 US 874 (1974), for the proposition that highlighting of relevant documents in an Information Disclosure Statement is required. Applicants respectfully note that this is not the holding of the Penn Yan Boats case.

In the Penn Yan Boats case, inequitable conduct was found because an applicant mischaracterized the source of a reference (the "Wollard patent") cited in a disclosure letter to the Patent Office. The applicant stated that the Wollard patent was uncovered as a result of a prior art search when, in fact, the applicant became aware of the Wollard patent, and of its relevance, subsequent to filing his patent application. The applicant also made reference to another patent, which he characterized as most relevant. Under these circumstances, and the disclosure requirements that existed at the time, the court found that the applicant had a duty to call the Examiner's attention to the Wollard patent and to distinguish it over the claims at issue.

In a later case, namely Molins PLC v. Textron Inc., 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995), the Federal Circuit made clear that there is no requirement to highlight references that an applicant believes to be particularly relevant. In the Molins PLC case, the applicant, in a reissue application, cited a number of references, which the Examiner indicated as having been considered. The cited references included one reference that the applicant knew to be

particularly relevant. There was no indication of the relevance of the one reference in the Information Disclosure Statement. The court, noting that the applicant did not mischaracterize the reference as in the Penn Yan Boats case, indicated that the citation was proper.

Copies of the Penn Yan Boats case and the Molins PLC case are enclosed.

For the reasons set forth below, Applicants submit that there is no requirement to indicate which references in the September 3, 2002 IDS are most relevant. Accordingly, Applicants respectfully request consideration of the references contained therein.

Applicants' undersigned attorney can be reached at the address shown below. All correspondence should be directed to Peter J. Devlin at the address shown below.

Respectfully submitted,

Date: _____

January 9, 2003



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